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20350 7590 04/30/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* JEFFRY J. GRAINGER  
9

10 Appeal 2008-005054  
11 Application 09/919,764  
12 Technology Center 2100  
13  
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16 Decided: April 30, 2010  
17  
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20 *Before:* ALLEN R. MACDONALD, *Vice Chief Administrative Patent*  
21 *Judge*, MURRIEL E. CRAWFORD, and JOSEPH A. FISCHETTI,  
22 *Administrative Patent Judges.*  
23

24 CRAWFORD, *Administrative Patent Judge.*  
25

26  
27 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 38. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a graphical user interface used to access documents and other information that is stored electronically and associated with a selected patent application (Spec. 1, para. [04]).

Claim 1 under appeal reads as follows:

1. A computer graphical user interface that provides access to information pertaining to a patent application, said graphical user interface comprising:

a first display section in which is displayed a plurality of first file links selectable by said user, each of said first file links providing access to a patent document that was filed in or sent from a patent office and that is stored on a computer-readable medium in an image file format, wherein when one of said first file links is selected an associated underlying resource is automatically returned; and

a second display section in which is displayed a plurality of second file links selectable by said user, each of said second file links providing access to a patent file that is associated with an application program and stored on a computer-readable medium;

wherein said patent documents and said patent files accessible from said first and second display sections all pertain to said patent application.

1 The prior art relied upon by the Examiner in rejecting the claims on  
2 appeal is:

3 Rivette US 6,499,026 B1 Dec. 24, 2002

4 The Examiner rejected claims 1 to 38 under 35 U.S.C. § 102(e)  
5 as being anticipated by Rivette.

6 The Examiner rejected claims 12, 19, 22, and 30 under 35 U.S.C. §  
7 103(a) as being unpatentable over Rivette.

8  
9 ISSUE

10 Did the Examiner err in finding that Rivette discloses a graphical user  
11 interface having a first display having a first link to access a patent  
12 document and second display having a second link to access a patent file  
13 wherein the patent document and the patent file pertain to the same patent  
14 application?

15  
16 FINDINGS OF FACT

17 The Appellant's Specification defines the term "'file link'" as  
18 something selectable by a user to access an underlying document (Spec. 11,  
19 para. [37]).

20 Rivette discloses a graphical user interface having a first display  
21 11704 called the group pane, a second display 11706 called the document  
22 pane, and a third display 11708 called the notes pane (col. 114, ll. 6 to 12,  
23 Fig. 117). A group hierarchy is depicted in the group pane 11704 and  
24 includes a link to select a member of the group (col. 115, 1-7). The  
25 documents pane includes user defined links (col.124, ll. 48-76, col.125, ll.  
26 1-7). The notes pane, in addition to the linkage of notes to portions of

documents, also includes hierarchically linkages e.g., a note may be a child note of any number of parent notes, and may have any number of child notes (col. 26, ll. 61-65).

The selected member is displayed in the documents pane (col. 114, ll. 61 to 66, Fig. 133). The notes panel displays a document selected in the documents panel (col. 114, ll. 47 to 48). A user of the Rivette system can create a new group in the group hierarchy (col. 116, ll. 44 to 46, Fig. 119). The created new group is a hierarchical child of a group that has been selected in the group display 11704 (col. 116, ll. 44 to 49). As such, Rivette discloses that a new group can be created by selecting the repository group in display 11704 and creating a new group as a child of the repository group. With the flexibility disclosed in Rivette, a user can create a new group which is a patent document that includes documents related to a particular patent application filed in or sent to a patent office. A patent file may be added to this new group (col. 118, ll. 31 to 44). As such, the new group is a patent document related to a particular application that includes a patent file. Therefore, the patent document group can be selected in the group display 11704 and the patent file displayed in the document display 11706. A document in the document display can then be selected and displayed in the notes display 11708. Each of these displays pertains to the particular patent application. Rivette discloses that a patent can be displayed in image or text format (col. 115, ll. 8 to 16).

#### PRINCIPLES OF LAW

A prior art apparatus having the same structure as a claimed apparatus renders a claimed apparatus unpatentable under § 102 as long as it is capable

of performing the claimed process or function. *In re Yanush*, 477 F.2d 958, 959 (CCPA 1973); *Ex Parte Masham*, 2 USPQ2d 1647, 1647 (BPAI 1987).

Nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

## ANALYSIS

### *Anticipation*

We initially note that as the rejection is based on 35 U.S.C § 102(e), it is only necessary that the Rivette graphical display function as claimed without deference to the content of the data being displayed. In this regard, we find that the limitations of the independent claims are met by Rivette.

Claim 1 requires

*a first display section in which is displayed a plurality of first file links selectable by said user, each of said first file links providing access to a patent document . . . ; and  
a second display section in which is displayed a plurality of second file links selectable by said user, each of said second file links providing access to a patent file . . . .*

(Emphasis added).

As found *supra*, in Rivette, each of the group pane, documents pane and notes pane include linkages, with at least the group and the notes panes including hierarchically linkages. We thus proceed with the understanding

1 that except for the particularities of the content of the data being handled by  
2 the Rivette system, Rivette meets the structure of the independent claims.

3 Accordingly, we are not persuaded that the Examiner erred by the  
4 Appellant's argument that the claimed subject matter relates to a single  
5 patent and the Rivette invention relates to a group of patents because the  
6 Rivette system is capable of being configured so as to relate to a single  
7 patent. e.g., the documents pane includes user defined links.

8 We are not persuaded of error on the part of the Examiner by  
9 Appellant's argument that Rivette does not disclose a first display with a  
10 plurality of links and a second display with a plurality of links. Rivette  
11 discloses and depicts in Figure 133 a group panel 11704 which has a  
12 plurality of folders that can be selected by a user to access underlying  
13 documents and, as such, the group panel 11704 of Rivette does disclose a  
14 plurality of file links. Rivette also discloses that a document can be selected  
15 in the documents panel to access underlying documents which may be  
16 displayed in the notes panel.

17 We are not persuaded of error on the part of the Examiner by  
18 Appellant's argument that Rivette does not disclose a graphical user  
19 interface having a first display having a first link to access a patent document  
20 and second display having a second link to access a patent file wherein the  
21 patent document and the patent file pertain to the same patent application.  
22 In this regard, we agree with the Examiner that the Rivette system has the  
23 flexibility to create and display a link to a patent document in the group  
24 display. The document display in Rivette is also capable of displaying a  
25 plurality of file links wherein the patent document and the patent file pertain

1 to the same patent application. This is so because Rivette teaches that a user  
2 can customize the displays by creating a new group and adding a document  
3 to the group.

4 We are not persuaded of error by the Examiner by Appellant's  
5 argument that Rivette does not disclose a patent file associated with an  
6 application program because we agree with the Examiner that the ability to  
7 display a document as text rather than just as an image in the Rivette  
8 disclosure is a disclosure that the document is associated with an application  
9 program.

10 With respect to claims 13 and 20, 32, and 33, we agree with the  
11 Examiner that because the Rivette system can be customized, it is capable of  
12 displaying correspondence information in the notes display including  
13 correspondence a user were merely have to add whatever correspondence  
14 desired to the a document displayed in the documents panel.

15 Notwithstanding, as we set forth initially, the recitations in the claims  
16 regarding the type of information displayed in the first, second, and third  
17 display can not patentably distinguish the subject matter of the claims  
18 because the display is not affected by being, specifically patent documents,  
19 patent files, or correspondence. Therefore, in our view the type of  
20 information displayed is merely nonfunctional descriptive matter and as such  
21 is not patentably consequential.

22 In view of the foregoing, we will sustain the Examiner's rejection of  
23 the claims under 35 U.S.C. § 102(e).



1 *Obviousness*

2 We will also affirm the Examiner's rejection of claims 12, 19, 22, and  
3 30 under 35 U.S.C. § 103(a) because the Appellant relies on the arguments  
4 made in response to the anticipation rejection in addressing this rejection  
5 which we found unpersuasive. In addition, we have sustained the rejection  
6 of claims 12, 19, 22, and 30 under 35 U.S.C. § 102(e) and anticipation is the  
7 epitome of obviousness. *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir.  
8 1984). *See also In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982); *In re*  
9 *Pearson*, 494 F.2d 1399, 1402 (CCPA 1974).

10  
11 CONCLUSION OF LAW

12 On the record before us we conclude that the Examiner did not err in  
13 rejecting the claims under 35 U.S.C. §§ 102(e) and 103(a).

14  
15 DECISION

16 The Examiner's rejection of claims is AFFIRMED.

17 No time period for taking any subsequent action in connection with  
18 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
19 § 1.136(a)(1)(iv) (2007).

20  
21 AFFIRMED

1 hh

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